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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/814,097	03/31/2004	Adam Iredell Hayden	1671-0297	7290
28/078 7590 10/05/2009 MAGINOT, MOORE & BECK, LLP CHASE TOWER 111 MONUMENT CIRCLE SUITE 3250 INDIANAPOLIS, IN 46204				
EXAMINER				
SCHILLINGER, ANN M				
ART UNIT		PAPER NUMBER		
3774				
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10/05/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/814,097

Applicant(s)

HAYDEN ET AL.

Examiner

ANN SCHILLINGER

Art Unit

3774

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 April 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 10, 13, 14, 31 and 38-53 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 10, 13, 14, 31 and 38-53 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/808)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114 was filed in this application after appeal to the Board of Patent Appeals and Interferences, but prior to a decision on the appeal. Since this application is eligible for continued examination under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e) has been timely paid, the appeal has been withdrawn pursuant to 37 CFR 1.114 and prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on 4/6/2009 has been entered.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 10, 13, 14, 31, 38-40, 42-49, 51, and 52 are rejected under 35 U.S.C. 102(b) as being anticipated by Ashby et al. (US Pat. No. 5,609,644). Ashby et al. discloses the following of claim 1: a patellar prosthesis comprising: a first subcomponent (1); a boss (7) operably connected to the first subcomponent; and a second subcomponent (10) movably connected to the first subcomponent with the boss, the second subcomponent comprising, a first side, the first side having (i) a channel therein (17), (ii) a boss retaining region (18) operable to retain the boss within the channel when the boss is inserted into the channel by contacting the boss, and (iii) a boss assembly region (left side of element 17) operable to

facilitate the insertion of the boss into the channel, by allowing the boss to pass through the boss assembly region for insertion of the boss into the channel (col.3, lines 35-46).

Ashby et al. discloses the following of claim 2: the patellar prosthesis of claim 1, wherein the first subcomponent comprises a base (4) and wherein the second subcomponent comprises an articulating subcomponent (11).

Ashby et al. discloses the following of claim 3: the patellar prosthesis of claim 1, wherein: the boss comprises a stem (bottom of element 7) and a head (top of element 7) having a width (Fig. 2); the channel has a first side and a second side, the second side spaced apart from the first side by a first distance (Fig. 6); and the boss retaining region comprises a lip (col. 3, lines 35-53), a first section having width and a second section having a width, the first section of the lip located on the first side of the channel and the second section of the lip located on the second side of the channel, the width of the head being greater than the first distance of the channel minus the width of the first section of the lip and minus the width of the second section of the lip (Fig. 6).

Ashby et al. discloses the following of claim 10: the patellar prosthesis of claim 1, further comprising: a spin stop (20) operably connected to the first subcomponent, and wherein the second subcomponent further comprises: a spin stop receiving chamber (19), the spin stop receiving chamber configured to receive the spin stop when the second subcomponent, boss and first subcomponent are assembled, such that the spin stop is movable within the spin stop receiving chamber (col. 4, lines 7-21)

Ashby et al. discloses claim 13 as shown in Figure 6.

Ashby et al. discloses the following of claim 14: the patellar prosthesis of claim 13, further comprising: a spin stop (20) operably connected to the first subcomponent, and wherein the second subcomponent further comprises: a spin stop receiving chamber (19) with a loading region, the loading region of the spin stop chamber configured such that when the boss is being inserted into the channel through the boss assembly region, the spin stop is inserted into the spin stop chamber loading region (Fig. 8).

Ashby et al. discloses the following of claim 31: a patellar replacement component base comprising: a generally planar bone contacting surface (4) lying in a first plane; a dome shaped contact surface (2) for contacting a patellar articulating component and located generally opposite the bone contacting surface; and a boss (7) having a stem (bottom of element 7) extending from the dome shaped articulating component contact surface along an axis, the axis of the stem intersecting the bone contacting surface plane at an angle of other than 90 degrees (Fig. 1-3).

Ashby et al. discloses the following of claim 38: the patellar replacement component base of claim 31, further comprising: a spin stop (20) extending from the dome shaped contact surface along an axis, the axis of the spin stop intersecting the bone contacting surface plane at an angle of other than 90 degrees (Fig. 1).

Ashby et al. discloses the following of claim 39: the patellar replacement component base of claim 38, wherein: the boss includes a head portion (top of element 7) extending outwardly from the stem portion, the head portion extending over a portion of the contact surface; and the spin stop is cylindrically shaped (Fig. 2).

Ashby et al. discloses claim 40 as shown in Figures 1-3.

Ashby et al. discloses the following of claim 42: a patellar prosthesis comprising: a first subcomponent (1); a boss (7) operably connected to the first subcomponent; and a second subcomponent (10) movably connected to the first subcomponent with the boss (col. 3, lines 35-53), the second subcomponent comprising, a first side, the first side having (i) a channel therein (17), (ii) a boss retaining region (18) having a first configuration operable to retain the boss within the channel when the boss is inserted into the channel by contacting the boss, and (iii) a boss assembly region (left side of element 17) having a second configuration operable to facilitate the insertion of the boss into the channel, the first configuration and the second configuration being different,.

Ashby et al. discloses the following of claim 43: the patellar prosthesis of claim 42, wherein the first subcomponent comprises a base (4) and wherein the second subcomponent comprises an articulating subcomponent (11).

Ashby et al. discloses the following of claim 44: the patellar prosthesis of claim 42, wherein: the boss comprises a stem (bottom of element 7) and a head (top of element 7) having a width; the channel has a first side and a second side, the second side spaced apart from the first side by a first distance (Fig. 6); and the boss retaining region comprises a lip (col. 3, lines 35-53), a first section having width and a second section having a width, the first section of the lip located on the first side of the channel and the second section of the lip located on the second side of the channel, the width of the head being greater than the first distance of the channel minus the width of the first section of the lip and minus the width of the second section of the lip (Fig. 6).

Ashby et al. discloses the following of claim 45: the patellar prosthesis of claim 42, further comprising: a spin stop (20) operably connected to the first subcomponent, and wherein the second subcomponent further comprises: a spin stop receiving chamber (19), the spin stop receiving chamber configured to receive the spin stop when the second subcomponent, boss and first subcomponent are assembled, such that the spin stop is movable within the spin stop receiving chamber (col. 4, lines 7-21).

Ashby et al. discloses claim 46 as shown in Figure 6.

Ashby et al. discloses the following of claim 47: the patellar prosthesis of claim 46, further comprising: a spin stop (20) operably connected to the first subcomponent, and wherein the second subcomponent further comprises: a spin stop receiving chamber (19) with a loading region (left side of element 19), the loading region of the spin stop chamber configured such that when the boss is being inserted into the channel through the boss assembly region, the spin stop is inserted into the spin stop chamber loading region (Fig. 8).

Ashby et al. discloses the following of claim 48: a patellar replacement component base comprising: a body (1) defining a generally planar bone contacting surface (4) lying in a first plane, a dome shaped articulating component contact surface (2) generally opposite the bone contacting surface; a stem (bottom of element 7) extending outwardly from the dome shaped articulating component contact surface of said body along a line, the line of the stem intersecting the bone contacting surface plane at an angle of other than 90 degrees; and a head (top of element 7) extending from said stem.

Ashby et al. discloses the claim 49 as shown in Figure 2.

Ashby et al. discloses the following of claim 51: the patellar replacement component base comprising: a integral body (1) defining generally planar bone contacting surface (4) lying in a first plane, a dome shaped contact surface (2) generally opposite the bone contacting surface; and a stem (bottom of element 7) extending outwardly from the dome shaped contact surface of said body in a direction away from the generally planar bone contacting surface along an axis, the axis of the stem intersecting the bone contacting surface plane at an angle of other than 90 degrees, the stem being integral with said body (Fig. 2).

Ashby et al. discloses the following of claim 52: the patellar replacement component base of claim 51, further comprising a head (top of element 7) extending from said stem.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 41 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ashby et al.

Ashby et al. discloses the claimed invention except for the dome contact surface being spherical. It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the dome shaped contact surface with a spherical shape, since such a modification would have involved a mere change in the shape of a component. A change in shape is generally recognized as being within the level of ordinary skill in the art.

Claims 50 and 53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ashby et al. in view of Whiteside et al. (US Pat. No. 5,019,104). Ashby et al. discloses the invention

substantially as claimed, however, Ashby et al. does not teach the implant's body, head, and stem being made of a polymer. Whiteside et al. teaches a patellar implant where the components may be made of a polymer in col. 1, line 45 through col. 2, line 6, 25-37 for the purpose of utilizing the material's biocompatibility. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the parts of the Ashby et al. reference from polymers in order to utilize the material's biocompatibility.

Response to Arguments

Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ANN SCHILLINGER whose telephone number is (571)272-6652. The examiner can normally be reached on Mon. thru Fri. 9 a.m. to 4 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Isabella can be reached on (571) 272-4749. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/A. S./
Examiner, Art Unit 3774

/DAVID ISABELLA/
Supervisory Patent Examiner, Art Unit 3774